REMARKS

I. Introduction

Claims 33 and 35-65 are pending in the present application after cancellation of claim 34. Claims 33, 41 and 59 have been amended. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are in allowable condition.

II. Rejection of Claims 33 to 65 under 35 U.S.C. § 103(a)

Claims 33, 55, and 57-58 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over EP 0 726 508 (Frampton; hereinafter referred as the "EP reference") in view of Wise (U.S. Patent No. 6,434,119). Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons.

To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 33 has been amended to recite the features previously contained in claim 34, i.e., "a third operating mode defines a standby phase in which the announcement channel is periodically monitored in previously defined time windows and at least one system component of one of the communication terminals is deactivated, and the announcement channel is monitored more frequently in the third operating mode than in the second operating mode, and in the second operating mode at least one more system component is deactivated, and a reactivation time in the second operating mode is longer than a reactivation time in the third operating mode." Since the EP reference and Wise do not teach or suggest the above-recited claimed feature (as evidenced by the application of an additional reference, U.S. Patent No. 6,356,538

("Li"), in support of the rejection of claim 34), amended claim 33 and its dependent claims 55 and 57-58 are not rendered obvious by the EP reference and Wise.

Claims 34-45, 48-51, 56 and 59-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over the EP reference, Wise and U.S. Patent No. 6,356,538 ("Li"). In view of the amendments of independent claims 33 and 59 to incorporate the features of now-canceled claim 34, Applicants will address claims 33, 35-45, 48-51, 56 and 59-65 in connection with the rejection based on the EP reference, Wise and Li.

Amended claim 33 recites, in relevant parts, "the **second operating mode defining a sleep phase** in which the announcement channel is monitored only at intervals . . . **a third operating mode defines a standby phase** in which the announcement channel is periodically monitored in previously defined time windows and at least one system component of one of the communication terminals is deactivated, and the announcement channel is **monitored more frequently in the third operating mode** than in the second operating mode, and in the second operating mode at least one more system component is deactivated, and **a reactivation time in the second operating mode is longer than a reactivation time in the third operating mode**." Amended claim 59 recites, in relevant parts, "**a second operating mode** including a **standby mode** and a **third operating mode** including a **sleep mode**, wherein . . . in the second operating mode the announcement channel is periodically monitored in previously defined time windows and at least one system component of one of the communication terminals is deactivated, and the announcement channel is **monitored more frequently in the second operating mode** than in the third operating mode, and in the third operating mode at least one more system component is deactivated, and **a reactivation time in the third operating mode is longer than a reactivation time in the second operating mode**." As can be seen from above, the "third operating mode" recited in claim 33 is equivalent to the "second operating mode" recited in claim 59; the "second operating mode" recited in claim 33 is equivalent to the "third operating mode" recited in claim 59. In support of the rejection of claim 34 (now applicable to amended claim 33), the Examiner contends that "Li teaches that such a third mode is known in the art (see Abstract and Figs. 4-8 of Li)." (Office Action, p. 3). However, the actual disclosure of Li clearly does not teach or

suggest the "third operating mode" feature of amended claim 33 (or the "second operating mode" feature of claim 59), as explained in further detail below.

As noted above, the "third operating mode" recited in amended claim 33 is "**a standby phase** in which the **announcement channel is periodically monitored in previously defined time windows** . . . and the announcement channel is **monitored more frequently in the third operating mode** than in the second operating mode, . . . and **a reactivation time in the second operating mode is longer than a reactivation time in the third operating mode**." Accordingly, the invention of claim 33 includes three distinction operating modes: a fully active operating mode (first mode); a sleep mode (second mode); and a standby mode (third mode). For the standby mode (third mode) of claim 33, the following conditions apply: a) "the announcement channel is periodically monitored in previously defined time windows"; b) "the announcement channel is **monitored more frequently in the third operating mode** than in the second operating mode"; c) at least one fewer system component is deactivated than in the second operating mode; and d) the reactivation time in the third operating mode (standby mode) is shorter than a reactivation time in the second operating mode (sleep mode). While Li discloses that different sets of circuit components may be selectively put into a low-power standby mode (also called the "sleep mode" in Li) while the remaining sets of circuit components are operated in the normal "operating mode," there is absolutely no suggestion in Li to provide separate "standby mode" and "sleep mode" which are distinguished by the above-referenced characteristics, e.g., the announcement channel is **monitored more frequently in the standby operating mode (third mode)** than in the sleep mode (second mode); at least one fewer system component is deactivated than in the second operating mode; and the **reactivation time in the standby mode is shorter** than a reactivation time in the sleep mode.

For at least the foregoing reasons, Applicants submit that claim 33 and claim 59 (which recites substantially similar limitations as the above-discussed limitations of claim 33), as well as their dependent claims 35-45, 48-51, 56 and 60-65, are not rendered obvious by the combination of the EP reference, Wise and Li.

Independent of the above, Applicants note that the Examiner's comments regarding dependent claims 35-45, 48-51, 56 and 60-65 are woefully deficient to establish a prima facie case of obviousness. As noted previously, the prior art reference(s) must teach or suggest **all of the claim limitations**. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). However, the Examiner does not discuss the specific claim limitations of the claims at issue; instead, the Examiner makes generalizations, e.g., "[w]ith respect to claim 35, since both references teach that synchronization is important, such a limitation is inherent in Li"; "[w]ith respect to claims 36-43, 45, 48-49, 56 and 59–65, note that with respect to the limitations contained in these claims, many would appear to be obvious in either the EP or Li references in order to maintain synchronization." (Office Action, page 3). However, such generalizations clearly do not address each claim limitation, and therefore such generalization cannot establish a prima facie case of obviousness. To the extent that the Examiner may be relying on the doctrine of inherent disclosure for the obviousness rejection, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy , 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)). However, the Examiner's asserted rationale for the alleged inherence of the claimed features clearly do not provide any "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." The fact that the claimed features may occur in the prior art does not establish inherence; instead, the claimed features must necessarily occur.

For at least the foregoing additional reasons, Applicants submit that dependent claims 35-45, 48-51, 56 and 60-65 are not rendered obvious by the combination of the EP reference, Wise and Li.

Claims 46-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of the EP reference and Wise in view of U.S. Patent No. 5,606,313 ("Allen"). Applicants note that claims 46-47 ultimately depend on claim 33. As noted above, the combination of the EP reference and Wise clearly does not render obvious claim 33. Furthermore, Allen fails to cure the deficiencies of the EP reference and Wise as applied against

parent claim 33. Accordingly, the combination of the EP reference, Wise and Allen fails to render obvious claims 46-47.

Claims 52-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of the EP reference and Wise in view of U.S. Patent No. 5,794,137 ("Harte"). Applicants note that claims 52-54 ultimately depend on claim 33. As noted above, the combination of the EP reference and Wise clearly does not render obvious claim 33. Furthermore, Harte fails to cure the deficiencies of the EP reference and Wise as applied against parent claim 33. Accordingly, the combination of the EP reference, Wise and Harte fails to render obvious claims 52-54.

III. Conclusion

In view of the above amendments and remarks, it is respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

KENYON & KENYON LLP

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By: JONG LEE for Gerard Messina

Gerard A. Messina
Reg. No. 35,952
One Broadway
New York, NY 10004
(212) 425-7200

CUSTOMER NO. 26646
PATENT & TRADEMARK OFFICE